



I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 743885422 US, in a BOX addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: May 3, 2006

Signature: *Lenzy Rogue*  
(Lenzy Rogue)

Patent  
Docket No. 532212000623

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:  
Thomas L. CANTOR

Serial No.: 10/617,489

Filing Date: July 10, 2003

For: METHODS, KITS AND ANTIBODIES  
FOR DETECTING PARATHYROID  
HORMONE

Examiner: C. Cheu

Group Art Unit: 1641

### SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT UNDER MPEP § 724.02

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. § 1.56 and MPEP § 724.02, the attention of the Patent and Trademark Office is hereby directed to the **SUBJECT TO PROTECTIVE ORDER** documents listed on the attached Form PTO/SB/08a/b. It is respectfully requested that the information be expressly considered during the prosecution of this application.

The document numbers 1-28 listed on the attached Form PTO/SB/08a/b are **SUBJECT TO PROTECTIVE ORDER** and should only be viewed by the Examiner or other authorized Patent and Trademark Office Employees. Pursuant to MPEP § 724.02, a copy of each document that is **SUBJECT TO PROTECTIVE ORDER** listed on the attached Form PTO/SB/08a/b is enclosed in a sealed, clearly labeled envelope.

05/08/2006 BABRAHA1 00000025 031952 10617489  
01 FC:1806 180.00 DA  
sd-312163

Document numbers 1-27 are from *Nichols Institute Diagnostics, Inc. v. Scantibodies Clinical Laboratory, Inc. and Scantibodies Laboratory, Inc.*, U.S.D.C. for the Southern District of California, case number 02 CV 0046 B (JMA), currently on appeal at the United States Court of Appeals for the Federal Circuit.

Document number 28 is from *Scantibodies Laboratory, Inc. v. Immutopics, Inc.*, currently pending in the United States District Court for the Central District of California, Case No. CV04-8871 GPS (MANx).

Pursuant to MPEP § 2004.13, the patent owner points out the following:

- Deposition of Thomas Cantor, taken on August 27, 2003 (Document No. 3 in the present Form PTO/SB/08a/b) in which Mr. Cantor answered questions about the use of PTH (1-9) peptide (*See e.g.*, Document No. 3 at pages 78-80.)
- The Confidential Deposition of Tom Cantor, taken on July 11, 2005 (Document No. 28 in the present Form PTO/SB/08a/b) may contain information potentially relevant to the Declaration of Thomas L. Cantor pursuant to 37 C.F.R § 1.132 as Exhibit A of the March 6, 2006 Amendment in Response to Non-Final Office Action in the present application.
- At page 00245, lines 12-13 of the Confidential Deposition of Tom Cantor, taken on July 11, 2005 (Document No. 28 in the present Form PTO/SB/08a/b), the sales figure of “Immutopics BioActive PTH ELISA assays” is redacted.

This Information Disclosure Statement is submitted:

- ☐ With the application; accordingly, no fee or separate requirements are required.
- ☐ Before the mailing of a first Office Action after the filing of a Request for Continued Examination under § 1.114. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☐ Within three months of the application filing date or before mailing of a first Office Action on the merits; accordingly, no fee or separate requirements are required. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☒ After receipt of a first Office Action on the merits but before mailing of a final Office Action or Notice of Allowance.
  - ☐ A fee is required. A check in the amount of \_\_\_ is enclosed.
  - ☒ A fee is required. Accordingly, a Fee Transmittal form (PTO/SB/17) is attached to this submission in duplicate.
  - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above; accordingly; no fee is believed to be due.
- ☐ After mailing of a final Office Action or Notice of Allowance, but before payment of the issue fee.
  - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a check in the amount of \_\_\_ is enclosed.
  - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a Fee Transmittal form (PTO/SB/17 is attached to this submission in duplicate.)

Applicant would appreciate the Examiner initialing and returning the Form PTO/SB/08a/b, indicating that the information has been considered and made of record herein.

The information contained in this Information Disclosure Statement under 37 C.F.R. § 1.97 and § 1.98 is not to be construed as a representation that: (i) a complete search has been made; (ii) additional information material to the examination of this application does not exist; (iii) the information, protocols, results and the like reported by third parties are accurate or enabling; or (iv) the above information constitutes prior art to the subject invention.

In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing 532212000623.

Dated: May 3, 2006

Respectfully submitted,

By 

Peng Chen

Registration No.: 43,543

MORRISON & FOERSTER LLP

12531 High Bluff Drive

Suite 100

San Diego, California 92130-2040

(858) 720-5117



ALTERNATIVE TO PTO/SB/08a/b (07-05)

<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  (Use as many sheets as necessary)				<b>Complete if Known</b>	
				Application Number	10/617,489
				Filing Date	July 10, 2003
				First Named Inventor	Thomas L. CANTOR
				Art Unit	1641
				Examiner Name	C. Cheu
Sheet	1	of	2	Attorney Docket Number	532212000623

U.S. PATENT DOCUMENTS					
Examiner Initials*	Cite No. <sup>1</sup>	Document Number Number-Kind Code <sup>2</sup> (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear

FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document Country Code <sup>3</sup> -Number <sup>4</sup> -Kind Code <sup>5</sup> (if known)	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T <sup>6</sup>

\*EXAMINER: Initial if information considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup> Applicant's unique citation designation number (optional). <sup>2</sup> See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.

NON PATENT LITERATURE DOCUMENTS – SUBJECT TO PROTECTIVE ORDER			
Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
	1.	Deposition of Claude D. Arnaud, taken on February 1, 2005	
	2.	Deposition of Gerald Bjorge, taken on January 27, 2005	
	3.	Deposition of Thomas Cantor, taken on August 27, 2003	
	4.	Deposition of Thomas Cantor (30(B)(6)), taken on September 11, 2003	
	5.	Deposition of Damon Cook, taken on June 16, 2003	
	6.	Deposition of Damon Cook (30(B)(6)), taken on September 12, 2003	
	7.	Deposition of Joseph O. Falkinham, taken on January 21, 2005	
	8.	Deposition of Wolf-Georg Forssmann, Ph.D., taken on August 25, 2003	
	9.	Deposition of Ping Gao, M.D., taken on June 18, 2003	
	10.	Deposition of Allen Garrett, taken on May 20, 2005	
	11.	Deposition of Thomas Godemeyer, taken on October 6, 2004	
	12.	Deposition of Mark Gray, taken on June 16, 2003	
	13.	Deposition of Dr. Richard Lerner, taken on January 13, 2005	
	14.	Deposition of Dr. Richard Lerner, taken on March 16, 2005	
	15.	Deposition of Markus Magerlein, Ph.D., taken on May 28, 2003	
	16.	Deposition of Markus Magerlein, Ph.D., taken on August 10, 2004	
	17.	Deposition of Michael Nordstrom (30(B)(6)), taken on September 17, 2003	
	18.	Deposition of K. Ramakrishan, Ph.D., (30(B)(6)), taken on August 13, 2003	
	19.	Deposition of K. Ramakrishan, Ph.D., (30(B)(6)), taken on September 3, 2003	
	20.	Deposition of Stephen Scheibel, taken August 8, 2003	
	21.	Deposition of Janet Sharp, taken on August 19, 2003	
	22.	Deposition of Randolph Wall, taken January 31, 2005	
	23.	Deposition of J. Stuart Woodhead, taken January 18, 2005	
	24.	Deposition of Zan Yang, Ph.D., taken on June 16, 2003	

Examiner Signature		Date Considered	
-----------------------	--	--------------------	--

sd-312151

Substitute for form 1449/PTO  <b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  <i>(Use as many sheets as necessary)</i>				<b>Complete if Known</b>	
				Application Number	10/617,489
				Filing Date	July 10, 2003
				First Named Inventor	Thomas L. CANTOR
				Art Unit	1641
				Examiner Name	C. Cheu
Sheet	2	of	2	Attorney Docket Number	532212000623

25.	Nichols Institute Diagnostics, Inc.'s Notice of and Ex Parte Application for Order to File Its Consolidated Confidential Declaration of April M. Alex in Support of (1) Nichols Institute Diagnostics, Inc.'s Motion for Judgment as a Matter of Law Re: Willfulness and in the Alternative for a New trial and (2) Nichols Institute Diagnostics, Inc.'s Motion For Enhanced Damages Under Seal, filed January 27, 2006	
26.	Consolidated Confidential Declaration of April M. Alex in Support of (1) Nichols Institute Diagnostics, Inc.'s Motion for Judgment as a Matter of Law Re: Willfulness and in the Alternative for a New trial and (2) Nichols Institute Diagnostics, Inc.'s Motion For Enhanced Damages, filed January 27, 2006	
27.	[Proposed] Order Granting Nichols Institute Diagnostics, Inc.'s Ex Parte Application to File Its Consolidated Confidential Declaration of April M. Alex in Support of (1) Nichols Institute Diagnostics, Inc.'s Motion for Judgment as a Matter of Law Re: Willfulness and in the Alternative for a New trial and (2) Nichols Institute Diagnostics, Inc.'s Motion For Enhanced Damages Under Seal, filed January 27, 2006, order signed Judge Brewster on January 31, 2006	
28.	Confidential Deposition of Tom Cantor, taken on July 11, 2005	

\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

<sup>1</sup>Applicant's unique citation designation number (optional). <sup>2</sup>Applicant is to place a check mark here if English language Translation is attached.

Examiner Signature		Date Considered	
-----------------------	--	--------------------	--